

intermediate layer extending over substantially an entire surface of said ground contact layer which is located directly beneath a foot of a person wearing the sport shoe, said intermediate layer being absent in areas between said ribs." Basis for this can also be found in Figures 7-8.

Claim 28 was rejected under 35 U.S.C. § 251 based upon "improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based." Claim 28 was also rejected under 35 U.S.C. § 102 as being anticipated by the U.S. patent to Barry et al '130 (of record in the original patent), and by the newly-cited U.S. patent to Tong et al. Claim 29 was also rejected under 35 U.S.C. § 251, under 35 U.S.C. § 112, first and second paragraphs, and under 35 U.S.C. § 102 as being anticipated by Tong et al. Considering these matters in order:

I. REISSUE RECAPTURE

The Examiner has based the rejection under 35 U.S.C. § 251 on the concept expressed in In re Clement that a broad scope surrendered in the application for the patent cannot be recaptured by the filing of a reissue patent application. Applicants recognize this restriction, but respectfully submit that Claim 28 and 29 (and new claims 30-31) are not restricted under In re Clement or MPEP § 1412.02 ("RECAPTURE OF CANCELLED SUBJECT MATTER").

According to In re Clement and MPEP § 1412.02, when analyzing recapture, one first applies a two-step test to determine if the claims have been broadened with respect to the patent claims, and whether this broadening relates to surrendered subject matter. However, this does not end the matter. One must then *separately* determine whether this broadening is barred by reissue recapture:

Once we determine that the Applicant has surrendered the subject matter of the cancelled or amended claim, we **then** determine whether the surrendered subject matter has crept into the reissue claim. Comparing the reissue claim **with the cancelled claim** is one way to do this. [citations omitted] If the scope of the reissue claim is the same as or broader than that of **the cancelled claim**, then the patentee is clearly attempting to recapture surrendered subject matter and the reissue claim is, therefore, unallowable. [citations omitted] **In contrast, a reissue claim narrower in scope [than the cancelled claim] escapes the recapture rule entirely.** [citations omitted]. (In re Clement, at 45 USPQ2d 1165; emphasis added).

Thus, even where, under the two step rule of In re Clement, it is determined that a claim has been broadened in an area related to surrendered subject matter, the broadened reissue claim "escapes the recapture rule entirely" if it is nonetheless narrower than the cancelled claim in all respects. Indeed, a broadened reissue claim which is broader than a cancelled claim in some respects will still escape the recapture rule **so long as it is narrower than the claims cancelled from the original application [not the patented claims] "in an aspect germane to a prior art rejection."** See MPEP § 1412.02, subheading entitled "REISSUE CLAIMS ARE BROADER IN SCOPE IN SOME RESPECTS, BUT NARROWER IN OTHERS": "If the reissue claim is narrower [than the cancelled claim] in an aspect germane to a prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim." At a minimum, reissue Claims 28-31 are narrower than the claim cancelled from the original application to obtain the patent in an aspect germane to a prior art rejection.

Original application Claim 1 recited an intermediate layer or rib, but included no recitation concerning the extent of the area of the intermediate layer. Claim 1 was cancelled in favor of new application Claim 27, which also recited an intermediate layer, but did not recite the degree or area of extent of the intermediate layer. In the Amendment After Final Rejection filed on September 2, 1994, on the other hand, the intermediate layer limitation was

narrowed to recite, for the first time, the area of extent of the intermediate layer, i.e., that the intermediate layer extends "over an entire surface of said ground contact layer."

Thus, the claim which was amended or cancelled during prosecution in order to gain patentability included no recitation concerning the extent of the area of the intermediate layer. By amending the claim to recite that the intermediate layer extends over the entire surface of the ground contact layer, Applicants surrendered a claim scope which had no restriction on the area of extent of the intermediate layer. Therefore, Applicants cannot now return to a claim scope which has no restriction as to the extent of area of the intermediate layer.

On the other hand, as set forth in In re Clement and MPEP § 1412.02, the reissue recapture rule does not bar a broadened claim that is nonetheless *narrower* than that cancelled as to an aspect germane to patentability, i.e., one which *does* include a restriction as to the extent of the area, even if that restriction is not as narrow as the claim of the issued patent.

Here, Claims 28 and 30-31 recite that the intermediate layer extends "over substantially the entire surface of the ground contact layer which is located directly beneath a foot of a person wearing the sport shoe." Claim 29 recites that the intermediate layer extends over "at least a surface of said ground contact layer which is directly beneath a lateral portion of a heel of a person wearing the sport shoe." In each case, the recitation of the extent of the area of the intermediate layer *is narrower than the claim scope which was surrendered in an aspect germane to the area of extent of the intermediate layer*. Thus, the scope of Claims 28 and 29 (or 30-31) is not barred by reissue recapture.

II. REJECTIONS UNDER 35 U.S.C. § 112

Claim 29 stands rejected under 35 U.S.C. § 112, first paragraph, as allegedly being based upon disclosure which is not enabling. Specifically, it is the position of the Examiner

that the claimed function of Claim 29 requires that "the intermediate layer must extend over a substantial surface of the sole, not merely over the lateral heel portion." However, this rejection is respectfully traversed.

Initially, the Examiner is reminded that:

Limiting an application to the preferred materials in the absence of limiting prior art would not serve the constitutional purpose of promoting the progress of useful arts. Therefore, an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made *only* when the language of the specification makes it clear that the limitation is critical for the invention to function as intended. *Broad language in the disclosure, including the Abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality.* (MPEP § 2164.08(c); emphasis added).

Unlike the case in In re Mayhew, such broad language is present in the present specification. Indeed, In re Mayhew, upon which the Examiner has relied, had language in the specification which specifically identified the limitation at issue as being critical for the invention to function as intended. In re Mayhew was directed to a method for producing a coated steel strip. The Examiner there rejected the claims as not being supported by the specification, without the inclusion of a step of cooling. This was affirmed by the CCPA, but only because the specification "states that the 'strip... and bath... are raised in temperature above what is ordinarily considered optimum coating temperatures. *This is practicable because of special cooling apparatus, specially located* " (188 USPQ at 358; emphasis in original). Thus, the specification in Mayhew made clear that the cooling zone limitation was critical to the invention. No such critical language is present in this application.

Instead, the present specification broadly describes the invention without mention of the extend of the area of the intermediate layer. The "Summary of the Invention" states that the intermediate layer is "arranged directly between the upper part of the contact layer, by one of its faces, and the lower part of the comfort layer, by its other face, and exhibiting

controlled torsional and flectional rigidity, and which provides simultaneously for the distribution of the shock areas sensed by the contact layer and their diffusion over the comfort layer, before coming in contact with the foot." The area of extent of the layer is not mentioned.

Similarly, in the "Description of the Preferred Embodiment" section describes "an intermediate layer or rib 9 of the sole 2, arranged directly between the upper part of the contact layer 7, by means of one of its faces 9a, and the lower part of the comfort layer 8, by means of its other face 9b. This layer 9 exhibits controlled torsional and flectional rigidity, assuring both distribution of the shock areas sensed by the contact layer 7 and their diffusion over the comfort layer, before contact with the foot 4." Again, the claimed function is described, but the area of extent of the intermediate layer is not mentioned as being required for providing the claimed function. Thus the language of the specification rebuts this rejection.

Similarly there is no support for the Examiner's allegation that Claim 29 is indefinite under 35 U.S.C. § 112, second paragraph, because the recited structure does not support the claimed function of providing for the distribution and diffusion of shockwaves and stresses (paragraph 5). Claim 29 recites that the intermediate layer extends over "at least" a surface directly beneath the lateral portion of the heel. This does not restrict the intermediate layer only to this portion; the claim can also include the case where the intermediate layer extends over a greater surface area, even over the entire surface area.

In addition, as noted above, the "Summary of the Invention" states that the intermediate layer "provides simultaneously for the distribution of the shock areas sensed by the contact layer and their diffusion over the comfort layer, before coming in contact with the foot," but no minimum area of extent of the layer is mentioned as being required for this

effect. Thus the specification provides no support for the Examiner's allegation that the area recited in Claim 29 is insufficient for the claimed function.

III. REJECTIONS UNDER 35 U.S.C. § 102

Claim 28 stands rejected under 35 U.S.C. § 102 as being anticipated by the U.S. patents to Tong et al or Barry et al '130. However, this is respectfully traversed.

Claim 28 recites that the intermediate layer has "controlled torsional and flecional rigidity" and extends "over substantially an entire surface of said ground contact layer which is located directly beneath a foot of a person wearing the sport shoe." There is no teaching for these features in Tong et al or in Barry et al '130.

For example, the insert member 56 in Tong et al (Figures 4-5) is provided for improving the rebound characteristics of the sole (col. 6, lines 1-3) and for preventing breakdown of the midsole material 28 due to fatigue (col. 6, lines 7-19).

However, the insert member 56 extends only in the heel area of the sole (see Fig. 4). **It is thus not present at the fore half of the sole.** The insert member is also limited in area by the spaces between the lateral extensions 60-72. Even a cursory examination of Tong et al thus indicates that the insert member 56 extends over *less than one half* of the ground contact layer which is located directly beneath a foot of a person wearing the shoe. The Examiner is, of course, permitted to give the claim terms their broadest reasonable interpretation, but this simply means that the Examiner can give the claim terms their "plain meaning" which would be understood by those of ordinary skill in the art. MPEP §2111.01. The partial insert member 56 of Tong et al cannot meet even this minimal test, and so does not disclose an intermediate layer extending "over substantially an entire surface" of a ground contact layer as is recited in Claim 28.

The insert member 120 of Tong et al (Figure 16) is also limited to the heel of the sole, and also has significant spaces between the lateral extensions at heel, and so the above remarks regarding insert member 56 apply here as well, i.e., it is limited in extent and cannot reasonably satisfy the plain meaning of an intermediate layer which extends “over substantially an entire surface of said ground contact layer which is located directly beneath a foot of a person wearing the sport shoe.”

Applicants note the slotted fingers 122 attached to the insert member 120 of this figure in Tong et al. However, it is further noted that the fingers 122 merely act as springs (col. 5, lines 34-35), and so cannot be considered a part of an intermediate layer “having controlled torsional and flecnional rigidity” as is recited in Claim 28.

Of course, the spring plate 17 of Barry is not present at the lateral part of the heel, and so also does not meet the minimal test for an intermediate layer which extends “over substantially an entire surface of said ground contact layer which is located directly beneath a foot of a person wearing the sport shoe” as set forth in MPEP §2111.01.

New Claims 30 and 31 recite that the intermediate layer includes a series of transverse ribs arranged in alternating fashion and extending across an axis of torsion of the sole. No corresponding ribs are present in Tong et al. Since such ribs are also absent in Barry et al ‘130, Applicants respectfully submit that Claims 30-31 clearly define over the applied art.

Concerning Claim 29, the only portions of the insert members 56 and 120 of Tong et al present directly beneath a lateral portion of the heel are the lateral projections 60-72 (and the corresponding parts in Figure 16). However, these are merely cantilever projections which are inherently incapable of the “controlled torsional and flecnional rigidity” recited in the claims. Thus, Claim 29 also defines over Tong et al.

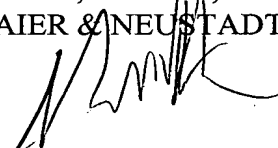
IV. OTHER MATTERS

Concerning paragraph 2 of the Office Action, the original patent, or a statement as to loss or inaccessibility of the original patent, will be submitted once all remaining issues have been resolved.

Applicants therefore believe that the present application is in a condition for allowance, and respectfully solicit an early notice of allowability.

Respectfully submitted,

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Marked-Up Copy
Serial No: 09/994,059
Amendment Filed on:
7-12-02

IN THE CLAIMS

Claim 30 (New)

Claim 31 (New)